

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



ExxonMobil Oil Corporation

Opposer,

v.

Hydac Filtertechnik GmbH

Applicant

Opposition No. _____

(Opposition to registration of
U.S. Trademark Application
No. 76/195253)

NOTICE OF OPPOSITION

ExxonMobil Oil Corporation, a corporation doing business at 5959 Las Colinas Boulevard, Irving, Texas 75039-2298 ("Opposer"), brings this Notice of Opposition against Hydac Filtertechnik GmbH, Industriegebiet D-66280, Sulzbach/Saar, Germany ("Applicant") with respect to Application Serial No. 76/195253 (the "Application") for registration of the mark MOBILMICRON (the "MOBILMICRON Mark"), which was filed on January 18, 2001 and published in the Official Gazette of May 7, 2002, and relation to which Opposer obtained extensions of time to oppose until and through May 16, 2006.

Opposer believes that it will be damaged by registration of the MOBILMICRON Mark, and hereby opposes registration of said mark.

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Grounds for Opposition.

As grounds for this opposition, Opposer states as follows:

1. Over the course of many years, Opposer, in its own name and through predecessors in interest, has used the trademark and service mark MOBIL, as well as composite trademarks, service marks and trade names that incorporate the designation MOBIL together with other words, symbols and/or designs (collectively hereinafter the "MOBIL Marks"), in commerce in the United States in connection with a variety of goods and services, and through such use Opposer has developed an extensive and favorable reputation as a provider of goods and services under such marks and names and has become well-recognized and respected in connection with such goods and services.

2. Opposer is owner of a large number of U.S. trademark and service mark registrations for the MOBIL Marks for a wide variety of goods and services, including U.S. Registration Nos. 363,312; 1,046,513; 1,049,824; 1,028,163; 1,041,060, and 1,048,286. Some of Opposer's registrations for the MOBIL Marks present the MOBIL designation with an upper-case letter "M" and lower case letters "obil", thus:

Mobil

3. Opposer is the owner of numerous U.S. trademark and service mark registrations for marks formed by the addition of other matter (such as words, letters or designs) to the core mark "MOBIL," including marks in which "MOBIL" forms the prefix portion of the mark, such as MOBILUBE as claimed in Registration No. 566,703 of November 11, 1952 (collectively subsumed herein as part of the "MOBIL Marks").

4. By virtue of many decades of use and promotion of the MOBIL Marks, the trademark MOBIL has become famous in commerce in the United States as an indicator of Opposer as the source of a variety of goods and services.

5. On January 18, 2001, Applicant applied to the U.S. Patent and Trademark Office for registration of the MOBILMICRON Mark for use in connection with:

IC 007: filters for industrial, construction and agricultural machines and for vehicles, and replacement parts therefor, namely, liquid filters, gas filters, multistage filters, change-over filters, filter elements, filter candles, filter cartridges, filter shells, filter disks, filter mats, filter pots, filter cloths, filter bags, filter belts, and filters for oil, gas, air fluid, hydraulic, pneumatic, kerosene, gasoline and diesel motors and engines;

IC 011: gas and liquid filters for heaters, ventilators, dryers, steam generators and air conditioners for commercial and industrial use, and replacement parts therefor, namely, multistage filters, change-over filters, filter elements, filter candles, filter cartridges, filter shells, filter disks, filter mats, filter pots, filter cloths, filter bags, filter belts, and water filtering units for sanitation, commercial and industrial use;

(hereinafter collectively "Applicant's Goods").

6. On information and belief, Applicant did not commence bona fide use of the MOBILMICRON Mark in commerce in or with the United States on or in connection with Applicant's Goods prior to January 18, 2001.

7. On information and belief, as shown in Exhibit 1 hereto, one manner in which Applicant has used the MOBILMICRON mark subsequent to January 18, 2001 is as follows:

Mobil® Micron Element

8. Since long prior to January 18, 2001, and long prior to any date upon which Applicant may rely as an actual or constructive date of first use in commerce

of the MOBILMICRON Mark, Opposer and its predecessors in interest have continuously used in commerce the MOBIL Marks in a variety of formats, including that depicted in paragraph 2, above, for a wide range of products and services.

9. Opposer's U.S. Registration Nos. 363,312; 566,703; 1,046,513; 1,049,824; 1,028,163; 1,041,060, and 1,048,286, and numerous other U.S. registrations of Opposer's MOBIL Marks, were issued by the U.S. Patent and Trademark Office long prior to the filing date of the Application.

10. Opposer's rights in and to the MOBIL Marks are superior to Applicant's rights in the MOBILMICRON Mark by virtue of Opposer's prior use and registration of the MOBIL Marks.

11. Opposer's MOBIL Marks became famous in United States commerce prior to January 18, 2001, and prior to any date on which Applicant may have first used the MOBILMICRON Mark.

12. In the United States, the MOBIL designation has one primary meaning to consumers, that being a trade name, trademark and service mark of Opposer.

13. The form of the MOBILMICRON Mark as it appears in Exhibit 1 hereto emphasizes the "Mobil" portion of the Applicant's mark by means of lettering that is confusingly similar, if not identical, to that employed by Opposer in displaying certain of its famous MOBIL Marks.

14. The form of the MOBILMICRON Mark as it appears in Exhibit 1 hereto separates and distinguishes the "Mobil" portion of the mark from the "Micron" portion thereof, thereby placing emphasis upon the "Mobil" designation.

15. The MOBILMICRON Mark is confusingly similar to Opposer's famous MOBIL Marks in terms of appearance, sound, meaning and overall commercial impression, and that confusing similarity is exacerbated by the form in which Applicant has chosen to display its MOBILMICRON mark in advertising and promotion as exemplified in Exhibit 1 hereto.

16. Due to the similarities in appearance, sound and meaning as between the MOBIL Marks and the MOBILMICRON Mark, consumers are likely to associate Applicant's MOBILMICRON Mark with Opposer, which is the source of goods and services sold under and by reference to the famous MOBIL Marks.

17. On information and belief, Opposer is a well-known source of goods and services that are offered, advertised, promoted, provided, and sold to classes of customers who are the same as or similar to the classes of customers to whom Applicant offers or will offer Applicant's Goods.

18. On information and belief, Opposer is a well-known source of goods and services that travel in channels of trade that are the same as those channels of trade through which Applicant's Goods are or will be offered.

19. Under the circumstances, on information and belief, the use of the MOBILMICRON Mark in connection with the Applicant's Goods is likely to falsely suggest a connection with Opposer and to cause confusion, mistake or deception as to the source of Applicant's Goods, and consumers are likely, when confronted with the MOBILMICRON Mark used in relation to Applicant's Goods, to believe, falsely, that the Applicant's Goods originate with, are sponsored by, are endorsed by, or are otherwise affiliated or connected with Opposer and Opposer's famous MOBIL Marks, all to the great damage and injury of Opposer, and Applicant's registration of the MOBILMICRON Mark will place a cloud over Opposer's title to its MOBIL names and MOBIL Marks, all in violation of the provisions of Sections 2(a), 2(d) and

43(a) of the Trademark Act of 1946 (as amended), 15 U.S.C. Sections 1052(a) and (d) and 1125(a).

20. Use and/or registration of the MOBILMICRON Mark in connection with Applicant's Goods will dilute the distinctive quality of Opposer's MOBIL Marks and will place a cloud over Opposer's title in and to those names and marks, all to the great injury and damage of Opposer, all in violation of the provisions of Section 43(c) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1125(c).

The statutory fee of \$600.00 is enclosed. Should any additional fees be required in connection with this filing, they may be deducted from and charged to the Deposit Account of Holland & Knight LLP, Deposit Account No. 50-1542.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and registration of the mark in Application Serial No. 76/195253 be denied.

Respectfully submitted,

EXXONMOBIL OIL CORPORATION

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Attorney for Opposer

EXHIBIT 1

Filter Elements **HYDAC**

Technical Details:

- Absolute filtration typically $\beta_{x(c)} \geq 1000$
- High β_x value stability across a wide range of differential pressures
- High contamination retention capacity
- Disposable elements and cleanable elements
- Compatible for filtration of mineral oils, non-flammable fluids, rapidly biodegradeable fluids, phosphate esters, water glycols, and high water based fluids
- Elements pleated
- Flow direction from out to in to maximize stability
- Return elements include integral bypass in endcap
- Good fluid compatibility due to the use of epoxy resin for impregnation and bonding
- Element protection resulting from high collapse burst pressure resistance (i.e. during cold start and differential pressure surges)
- Excellent flow fatigue stability due to solid filter material support
- Standard filtration ratings: 3 μ m, 5 μ m, 10 μ m, and 20 μ m absolute

Wire Mesh Element

- High temperature range
- Corrosion protection due to stainless steel filter material and tin-plated or nickel-plated steel parts
- Cleanable
- Filtration ratings: 25 μ m, 50 μ m, 74 μ m, 100 μ m, 149 μ m, and 200 μ m nominal

Metal Fiber Element

- Safeguards high filtration efficiency even at extreme dynamic loads
- High contamination retention capacity due to deep filtering which results in a longer service life
- Low flow resistance
- Corrosion protection due to stainless steel filter material and tin-plated steel parts
- High differential pressure tolerance
- Economical due to cleanability
- High temperature range
- Filtration ratings: 3 μ m, 5 μ m, 10 μ m, and 20 μ m nominal / or absolute ratings - *Consult Factory*

Disposable Polyester (paper) Element

- Higher contamination retention capacity than cellulose due to deep filtration
- Low flow resistance
- Media supported on both sides with wire mesh
- Good fluid compatibility due to media being free of bonding agent
- Filtration ratings: 10 μ m, and 20 μ m nominal
- Non cellulose media (*polyester*)- plastic coating eliminates swelling

Mobil® Micron Element

- Extremely low ΔP across elements when utilized with high viscosity fluids or cold start conditions
- Melt blown fiberglass media construction
- Good dirt holding capacity
- High filtration efficiencies $\beta_{x(c)} \geq 200$
- Good beta stability